

Docket No. 0505-1206P

Appl. No.: 10/609,415

Art Unit: 3681

Amendment dated September 23, 2004

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REMARKS

Applicants appreciate the Examiner's thorough consideration provided in the present application. Claims 1 and 3-18 are currently pending in the instant application. Claims 1, 9, 13, 14 and 17 have been amended and claim 18 has been added. The subject matter of additional claim 18 is fully supported by the original written description, including, but not limited to original claims 1 and 11. Claims 1, 9, 13, 17 and 18 are independent. Reconsideration of the present application is earnestly solicited.

Allowable Subject Matter

Applicants appreciate the Examiner's indication of allowable subject matter. Specifically, the subject matter of claims 9, 10, 12 and 17 has been indicated as being allowable if rewritten in independent format. Without conceding the propriety of the Examiner's rejections, but merely to expedite the prosecution of the present application, Applicants have amended claims 9 and 17 into allowable, independent format. Accordingly, as indicated by the Examiner in the Office Action, claims 9, 10, 12 and 17 should be allowed. In addition, as described in greater detail hereinafter, Applicants submit that all of the claims should be allowed and the present application should be passed to Issue.

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Priority

Applicants appreciate the Examiner's indication of acceptance of the certified copy of the corresponding priority document for the present application.

Drawings

Applicants respectfully request approval of the formal drawings filed on July 1, 2003. Specifically, Applicants have not received a Notice of Draftsperson's Patent Drawing Review (PTO-948) indicating that the formal drawings have been approved. However, since the Examiner has not cited any informalities with the drawings, Applicants submit that the formal drawings should be approved. In the absence of additional comments from the Examiner, Applicants will not take any further action with respect to the drawings.

Claim Rejection Under 35 U.S.C. § 102

Claims 1 and 3-4 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Oguri (U.S. Patent No. 6,655,226). This rejection is respectfully traversed.

In light of the foregoing amendments to the claims, Applicants respectfully submits that all of the rejections have been obviated and/or rendered moot. Without conceding the propriety of the Examiner's rejection, but merely to expedite the prosecution of the present application, Applicants have amended claim 1 to clarify the invention for the benefit of the Examiner. Specifically, Applicants submits that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention. Accordingly, this rejection should be withdrawn.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of limitations of the claimed invention, including the feature(s) of: "an output shaft driven gear fixed to said output shaft, said output shaft driven gear meshing with said forward drive gear and said second intermediate gear, *wherein said output shaft driven gear is the only gear attached to said output shaft.*" (Emphasis Added) Accordingly, this rejection should be withdrawn.

As admitted by the Examiner, the automatic transmission of Oguri does not teach or suggest an output shaft an output shaft driven gear fixed to the output shaft, the output shaft driven gear meshing with a forward drive gear and a second intermediate gear. In addition, Oguri does not teach or suggest that the output shaft driven gear is the only gear attached to the output shaft.

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In Oguri, the output shaft (element 14) clearly and purposefully is provided with a forward driven gear (23b), a first driven gear (21b), a second driven gear (22b), a third driven gear (23b), a fourth driven gear (24b), a fifth driven gear (25b) and a sixth driven gear (26b). All of these gears are provided in operative engagement with corresponding drive gears (21a-26a) that are specifically mounted on an input shaft (13). Accordingly, this rejection should be withdrawn.

Claim Rejection Under 35 U.S.C. § 103

Claims 2, 6-8 and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Oguri in view of Official Notice. Claims 5 and 13-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Oguri in view of Shinobu (Japanese Patent Abstract No. 60179328 A). These rejections are respectfully traversed.

Applicants submit that these rejections based upon the Oguri reference are improper and/or fail to establish a proper *prima facie* case of obviousness. Accordingly, the foregoing amendments and the enclosed remarks have not been made responsive to a proper statutory rejection advanced by the Examiner.

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Applicants respectfully traverse the Examiner's use of Official Notice to allegedly cure the deficiencies of the Oguri reference. The Examiner has admitted that Oguri does not teach or suggest that the output shaft driven gear is the only gear attached to the output shaft. In Oguri, the output shaft (element 14) clearly and purposefully is provided with a forward driven gear (23b), a first driven gear (21b), a second driven gear (22b), a third driven gear (23b), a fourth driven gear (24b), a fifth driven gear (25b) and a sixth driven gear (26b). All of these gears are provided in operative engagement with corresponding drive gears (21a-26a) that are specifically mounted on an input shaft (13). The Examiner has indicated that it would have been obvious to one of ordinary skill in the art to "modify Oguri to omit the remaining gears of different ratios on the output shaft, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. In re Karlson, 136 USPQ 184." (see page 3 of the Office Action) These gears cannot be merely omitted as suggested by the Examiner. These gears are all provided in operative engagement with corresponding drive gears. Further, Oguri's automatic transmission is specifically directed at an "automatic transmission for a vehicle having a plurality of gear trains" (see any of the claims of Oguri and Abstract). Omitting these gears as alleged by the Examiner

would clearly be in direct contrast to the expressed teachings of Oguri and clearly result in an inoperative, automatic transmission without a plurality of gear trains.

In re Karlson clearly does not support the modification of Oguri suggested by the Examiner. Applicants submit that in this case, the rejection discussed by the court involved a secondary teaching from a secondary reference. Therefore, this case in no way permits Examiners to omit structural details, particularly essential features, from references without supporting evidence from the prior art of record. Further, omitting the gears referred to by the Examiner will render the Oguri device inoperative as specifically intended. Accordingly, this rejection is improper and should be withdrawn.

With respect to the Examiner's suggestion that Oguri teaches or suggests a manual transmission, this opinion is respectfully traversed. Applicants submit that Oguri is specifically directed at an automatic transmission. The alleged "manual transmission" of Oguri in col. 1 referred to by the Examiner is related only to the background art. Oguri specifically avoids any manual features as Oguri is purposefully directed at an automatic transmission (see Title, Abstract and the claims), i.e., not a manual transmission. "It is an object of the present invention to provide an AMT [Automatic Manual Transmission] type automatic transmission capable of reducing the number of gears of gear

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trains and the longitudinal size of the automatic transmission.” Therefore, the Examiner’s suggestion that it would have been obvious to “modify Oguri to employ a manual operated dog clutch, since Oguri teaches of a manual transmission (Col. 1) and in order to provide more control to the operator” (see page 4 of the Office Action) is in direct contrast to the expressed teachings and intended purpose of Oguri. Accordingly, this rejection is improper and should be withdrawn.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicants respectfully submit that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicants respectfully submit that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

CONCLUSION

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of-the-art, no further comments are deemed necessary with respect thereto.

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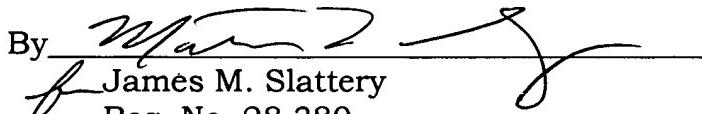
All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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